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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,318	01/29/2004	John B. Carilli		5485

7590 01/27/2006

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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,318

Applicant(s)

CARILLI, JOHN B.

Examiner

Mark S. Graham

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 3 and 5 and 6 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

In claim 3, "the device's base center fitting" lacks proper antecedent basis.

Claims 5 and 6 are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuertemburg. Wuertemburg discloses the claimed invention with the possible exception of the claimed diameter. (It is assumed by adaptable wall height that applicant is simply indicating that the device may be manufactured of different heights). Wuertemburg does not disclose the exact outer diameter of his device though it is clearly close to regulation cup size. However, Wuertemburg makes clear that it may be sized as desired and it would have been obvious to make it the same size as a regulation cup to simulate actual golf conditions. Regarding the use of pvc or polycarbonate, Wuertemburg does not disclose the type of plastic out of which his device is constructed. However, the examiner takes official notice that both pvc and polycarbonate are commonly known. Because both materials are commonly known and suitable

for Wuertemburg's purpose the use of such to construct the device cannot be considered unobvious.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuertemburg in view of Barlow. Wuertemburg obviates the claimed device with the exception of the drainage for the reasons explained in the claim 1 rejection. However, as disclosed by Barlow it is known in the art to use drain holes on putting practice devices for their inherent purpose. It would have been obvious to one of ordinary skill in the art to have done the same with Wuertemburg's device as well to allow for use in an outdoor setting.

With regard to claim 6, the examiner took official notice that aluminum rivets, (which are considered the plastic cup ring retainers) are commonly known and used as a fastener and such is now admitted prior art. It would have been obvious to one of ordinary skill in the art to have used such on Wuertemburg's device to construct it if such a fastening system was most readily available to the ordinarily skilled artisan.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin in view of Wuertemburg. Austin discloses the claimed device with the exception of the use of a cup base adapted to fit within synthetic turf. However, as disclosed by Wuertemburg such are known in the art. It would have been obvious to one of ordinary skill in the art to have used such with Austin's device to allow it to better mimic an actual golf cup in a green. Wuertemburg also teaches that it is known in the art to use plastics to construct such devices and the use of such in Austin's device would have been obvious to save cost.

Concerning claim 3, the actual color of Wuertemburg's device would have been up to the ordinarily skilled artisan depending on the aesthetic nature desired in the device. Applicant's

comments regarding the color of the disc have been noted but merely relate to what the examiner has noted - that the choice of color is based on what is aesthetically pleasing. Choosing an aesthetically pleasing color (or lack thereof) for the Austin/Wuerttemberg device would have been within the realm of the ordinarily skilled artisan. It is noted that applicant did not attach any particular criticality to the color of the device in the originally filed disclosure and no evidence of a functional distinction of the color has been provided.

Regarding claim 4 an audible sound will inherently result when using Austin's device. What is considered appealing is up to the user.

Applicant's arguments with respect to claims 1-6, aside from what has been addressed above, have been considered but are moot in view of the new ground(s) of rejection.

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$250.00.

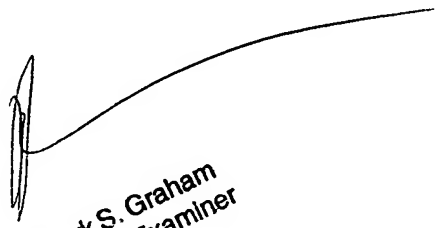
If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

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A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG
1/13/06



Mark S. Graham
Primary Examiner